

## **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of July 20, 2006 (Office Action). As this action is timely filed within the three-month shortened statutory period, no fees are believed due. However, the Office is expressly authorized to charge any deficiencies or credit any overpayments to Deposit Account 50-0951.

Claims 1-3, 7-9, 11-13 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2002/0010000 to Chen, *et al.* (hereinafter Chen), in view of U.S. Patent No. 6,385,602 to Tso, *et al.* (hereinafter Tso), and in further view of U.S. Published Patent Application No. 2002/0083090 to Jeffrey, *et al.* (hereinafter Jeffrey). Claims 4-6, 9-10 and 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen, in view of Tso, and in further view of Jeffrey, as applied to claims 1, 7, and 11, and further in view of Pitt, *et al.*, *An Improved Auditory Interface for the Exploration of Lists*, ACM Multimedia 97 (hereinafter Pitt).

### **Claim Amendments**

Dependent Claims 1 and 14 have been amended to correct the informalities noted at page 3 of the Office Action. Specifically, in each of the claims the word "on" has been inserted between the words "based" and "said," as suggested by the Examiner. Applicants thank the Examiner for directing Applicants' attention to the informalities and for suggesting the proper corrections. The amendments are fully supported in the Specification and do not introduce new matter.

### **Applicants' Invention Predates Jeffrey**

As noted above, Claims 1-17 were rejected at page 2 of the Office on the basis of new grounds of rejection. It is acknowledged in the Office Action that neither the combination of Chen and Tso nor the combination of Chen, Tso, and Pitt teaches or

suggests every feature recited in the claims. Rather, the rejection of Claims 1-3, 7, 8, 11-13, and 17 was based upon Jeffrey as well as Chen and Tso. Claims 4-6, 9, 10, and 14-17 likewise were rejected on the basis of Jeffrey as well as Chen, Tso, and Pitt.

Applicants respectfully disagree that either combination, even with Jeffrey included, teaches or suggests the respective sets of claims. Applicants respectfully submit, however, that the issue is moot because Applicants' invention predates the December 27, 2000, effective date of Jeffrey. In support of their assertion, Applicants submit their Declarations, attached hereto, to establish conception and continuing diligence from a time prior to the effective date of Jeffrey up to the filing of the Application.

Along with the Declarations, Applicants also submit herewith a copy of Confidential Invention Disclosure No. BOC8-2000-0079, titled *Compressed List Presentation for Speech User Interfaces* (Disclosure). The Disclosure was submitted on September 26, 2000, by Applicants to an intellectual property (IP) professional employed by the assignee of Applicants' invention, International Business Machines Corporation (IBM). The Disclosure was insubstantially modified the following day, September 27, 2000, by an IBM IP professional for administrative purposes. No substantive modifications were made to the Disclosure after the initial submission. Indeed, as explained below, IBM internal procedures preclude any modification at all to the actual description of the invention once a disclosure has been submitted to an IBM IP professional.

The Disclosure explicitly describes Applicants' invention. Accordingly, all of the features that form the subject matter of the present Application are described in the Disclosure. The written description provided in the Disclosure is clear evidence of Applicants' conception of the claimed subject matter at least as early as September 26, 2000.

The Disclosure is an IBM confidential disclosure form. It is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-adhered-to internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Attorney/IP Professional; no modifications at all can be made to the portions that describe the invention disclosed in the document.

The written description, drawings, and each of the claims of the Application were prepared based upon Applicants' attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

Applicants exercised due diligence from prior to the effective date of Jeffrey to the date that the Application was filed. As expressly affirmed in the Declarations, Applicants from at least September 26, 2000, through the filing of the Application, worked diligently toward a constructive reduction to practice of the invention, first with IBM's own in-house IP professionals, and then with outside counsel retained by IBM to prepare and file the Application.

The Disclosure was provided to outside counsel along with a letter from an IBM IP professional requesting that outside counsel prepare and file the Application. A copy of the letter, dated November 17, 2000, is attached hereto. Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated with dates are granted priority within the

Appln. No. 09/894,608  
Amendment dated October 20, 2006  
Reply to Office Action of July 20, 2006  
Docket No. 6169-208

work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case.

### CONCLUSION

The Applicants believe that this application is now in full condition for allowance. Allowance of the application, accordingly, is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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